

### **REMARKS**

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

#### ***Status of the Claims***

Claims 1-9 are currently pending in the present application. The Office Action is non-final. Claims 1-5 have been amended without prejudice to or disclaimer of the subject matter contained therein. Claims 6-9 have been added. No new matter has been added by way of the amendments. Support for new claims 6-8 can be found at paragraph [0014] of the present specification and support for new claim 9 can be found at paragraph [0013] of the present specification.

Based upon the above considerations, entry of the present Amendment is respectfully requested.

#### ***Issue Under 35 U.S.C. § 102(b)***

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Takenawa et al. (translation of JP PN 10204408, hereinafter referred to as Takenawa). Applicants respectfully traverse this rejection.

Independent claim 1 relates to a thickening composition comprising a xanthan and a potassium salt, wherein said potassium salt is attached to a powder surface of the xanthan gum. Claim 2 of the present invention requires that the xanthan gum having a potassium salt attached to a powder surface thereof be prepared by a method comprising the steps of spraying a potassium salt solution to the xanthan gum, and thereafter fluidizing and drying the sprayed xanthan gum.

Takenawa discloses that an alkali metal salt of gluconic acid is mixed with a low water-soluble substance such as xanthan gum, and the resulting mixture is dispersed and dissolved in water (see [0006]). However, the "attachment" in the present invention cannot be obtained by simply mixing an alkali metal salt of gluconic acid with xanthan gum.

As explained in paragraph [0014] of the present specification, the attachment in the present invention refers to an attachment state of the particle of the potassium salt to the particle surface of the xanthan gum, including an attachment state of a particle where a potassium in a crystalline state is attached to a particle surface of a xanthan gum, i.e., a state where a potassium salt serving as a binder or a coating agent is attached to a surface of a xanthan gum. In one embodiment it is a state where the attachment of the particle is maintained even when subjected to a 30-second vibration on a 60-mesh sieve. The fine powder crushed by vibration that passes through the 60-mesh sieve may be 20% by weight or less. Here, the particle size of the powder of a general xanthan gum or potassium chloride is finer than 60 mesh. Therefore, when a powder obtained by simply mixing the powders of xanthan gum and potassium chloride is sieved with a 60-mesh sieve, 100% of the powders theoretically pass through the sieve.

In the present invention, a potassium salt is attached to a powder surface of the xanthan gum. Thereby, water wettability of the surface of the xanthan gum is improved and thus, water dispersibility is improved so that a reaching rate to a peak viscosity can be remarkably improved (see [0010]). In this regard the Examiner is requested to compare Example 1 with Comparative Example 1.

In Example 1, potassium salt-attached xanthan gum is prepared by the method recited in claim 2. Whereas, in Comparative Example 1, xanthan gum in powder is mixed with potassium salt in powder and then water is sprayed thereto and the mixture is dried. By mixing both the xanthan gum and potassium salt in powder form, however, the effects of the present invention cannot be exhibited. That is, Takenawa discloses simply mixing an alkali metal salt of gluconic acid with xanthan gum, which corresponds to Comparative Example 1 of the present invention. Thus, Takenawa fails to either suggest or inherently achieve, the present invention.

A theory of inherency must be supported by facts and/or technical reasoning that reasonably support a determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy* 17 USPQ2d 1461 (BPAI 1990) (emphasis added). In order for prior art to anticipate a claimed compound on the ground it is inherently produced in a prior art process, the inherency must be certain. *Glaxo, Inc. v. Novopharm Ltd.*, (EDNC 1993) 830 F. Supp 871, 29 USPQ2d 1126; *Ex parte Cyba* (POBA 1966) 155 USPQ 756;

*Ex parte McQueen* (POBA 1958) 123 USPQ 37. The fact that a prior art article may inherently have the characteristics of the claimed product is not sufficient. *Ex parte Skinner* (BPAI 1986) 2 USPQ2d 1788. Inherency must be a necessary result and not merely a possible result. *In re Oelrich* (CCPA 1981) 666 F2d 578, 212 USPQ 323; *Ex parte Keith et al.* (POBA 1966) 154 USPQ 320.

Thus, in the present instance, the evidence support the assertions that the cited art fails to inherently achieve the claimed limitations. That is, as in Comparative Example 1, Takenawa fails to achieve the present limitation of "xanthan gum in which a potassium salt is attached to a powder surface of the xanthan gum" as recited in claim 1. This rejection is therefore improper and should be withdrawn.

***Issue Under 35 U.S.C. § 103(a)***

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Takenawa et al. (translation of JP PN 10204408, hereinafter referred to as Takenawa) in view of Marrs et al. (U.S. 5,633,030, hereinafter referred to as Marrs). Applicants respectfully traverse.

Claim 5 is patentable for the same reasons discussed above. Moreover, the secondary reference of Marrs does not cure the above deficiencies. Thus, this rejection is likewise overcome.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig A. McRobbie, Reg. No. 42,874, at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


Application No. 10/577,301  
Reply to Office Action of January 23, 2009

Docket No.: 1422-0715PUS1  
Art Unit: 4790

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: APR 22 2009

Respectfully submitted,

By  #42874  
Gerald M. Murphy, Jr.  
Registration No.: 28,977  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant